

REMARKS

1. Claims 9, 10, 14 and 20 are amended to render them more definite and certain and are not amended in response to any rejection. No new matter is added.

2. Claims 1-2, 4-8, 13-17 and 21 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent 6,789,108 (MCMILLAN). The applicant respectfully requests the Examiner to withdraw the rejection of these claims in view of the following remarks distinguishing the claims over MCMILLAN.

Claim 1

MCMILLAN describes a media distribution system in which a sender sends media content and other files to a server computer. The server computer then sends email to receiver computers containing code that causes the media to be played by media programs that may be on the receiver computer when the email is opened.

MCMILLAN teaches (col. 1, lines 35-47) that when an advertiser sends email to a user containing special content such as rich media that requires special programs (such as Flash, Shockwave, Windows Media) on the user's computer for the user to view it, that often only about 10% of the recipients are able to view it because their computers lack the special programs. MCMILLAN therefore teaches to provide email with software embedded in the email that determines which media programs are available on the recipient's computer and then runs the program providing the best results (col. 1, lines 55-52). In some cases, the embedded software will direct a recipient computer to download a data file such as streaming audio or video from the server.

MCMILLAN also teaches at col. 9, lines 15-52) that the server should keep track of various information about the emails and data files it sends, including such things as the IP address and domain of each recipient computer, the method that the recipient accessed the data file. etc. However, in addition to keeping track of the receiving computers to which the emails and multimedia files were sent, system users might also want to know whether a recipient actually viewed the email or played the multimedia file. While

MCMILLAN's server keeps a log of when a file was sent to a receiver, it does not keep a record of whether the receiver actually viewed the document or played the media described by the file. For example, although the server records who it sent an email, it is possible that the recipient will not actually receive it, and even when a recipient does receive an email, the recipient may not open the email. Also, even though the recipient may try to open the email, it is possible that the recipient's email program will fail to successfully display the entire email, as for example when the email is corrupted or the email program has a defect. In any of these cases, though the server will record that an email was sent to a particular recipient, it will not have been displayed. Similarly, MCMILLAN's server may record the fact that it sent, for example, a web page or a media file to a particular recipient, but it will not be able to record whether the recipient successfully viewed the web page in a browser or played the media file on a media player. The server knows only that it sent a file to a recipient and has no way of knowing for sure exactly what the recipient did with that file.

Step c of the applicant's claim 1 relates to the notion of notifying the server computer when a receiver computer has successfully displayed a document. In particular, step c recites that software executed by the receiver computer displays an image of a document described by a document file it has received from a server and then "automatically return[s] verification data to the server computer ... verifying that the receiver computer has successfully displayed the document image." As recited in claim 2, this return verification enables the server to log the fact that the document was actually viewed, not merely that it was sent.

MCMILLAN (col. 9, lines 15-25) teaches that a server should keep track of certain kinds of information regarding the emails it sends, such as the IP address of the recipient, domain of the sender, bytes sent etc. However, MCMILLAN does not teach that the server should log receipt of the recited verification data from the receiving computer. The types of programs (browsers, media players etc) on the recipient's computer that MCMILLAN's embedded email software makes use of are not adapted to send verification data back to the source of the files they receive verifying that they actually displayed or played the content of the files. As discussed in the applicant's specification, it is

necessary to provide a browser with a special plug-in which does send acknowledgment data back to the sever when the browser has successfully displayed a document. MCMILLAN does not teach this.

The Examiner errs in pointing to FIG. 12, 340 and col. 8, line 49 through col. 9, line 52 as teaching software receiving in a receiving computer that sends data to a server acknowledging that it has successfully displayed a document. FIG. 12 is a flow chart illustrating a portion of the process carried out by a server computer after sending out emails to recipients. None of the steps 341-347 teach anything about receiving the recited acknowledgment data from software residing on the receiving computers. MCMILLAN's col. 8, line 49 through col. 9, line 52 indicates that the steps of FIG. 12 carried out by a content server include the following:

1. determining whether a job is "internal" or "partner",
2. maintaining a count of how many times a data file is sent to a recipient,
3. sending email to a database server notifying it that it sent an email to a recipient and indicating whether the email was undeliverable,
4. keeping "tracking records" relative to the files sent out including such information as recipient IP address, domain of user, method of access, login information, etc., and
5. preventing a recipient from accessing a data file too many times.

MCMILLAN's col. 8, line 49 through col. 9, line 52 talks only about what the server computer does, and does not teach anything about what the receiving computer does. In particular, the cited lines of MCMILLAN fail to teach or suggest that the receiving computer should send verification data to the server computer verifying that it has successfully displayed the content of a data file as recited in the claim 1, step c. The applicant's claim 1 is therefore patentable over MCMILLAN since MCMILLAN fails to disclose or suggest step c.

Claim 2

Claim 2 depends on claim 1 and is patentable over MCMILLAN for similar reasons. Claim 2 is further patentable over MCMILLAN because it recites storing log data on the server computer indicating when

the receiver computer returned the verification data. The Examiner cites MCMILLAN FIG. 13, and col. 9, lines 15-52 as teaching this. However, while FIG. 13 and the cited section of MCMILLAN teach that the server computer should log information relative to the files it forwards to receiver computers, nothing in MCMILLAN teaches that such information should include data from the receiver computer verifying that it has successfully displayed or played the content of a data file as recited in claim 1.

Claims 4-6

Claims 4-6 depend on claim 1 and are patentable over MCMILLAN for similar reasons. Claim 4 is further patentable over MCMILLAN because it recites "transmitting a publish request from the sender computer to the server computer [identifying] the receiver computer". The Examiner points to MCMILLAN, col. 8 lines 3-16) as teaching this. However, this section of MCMILLAN teaches only that

1. content is sent from one server to another
2. servlets are sent to a server that generates email
3. email is sent to the content creator as a test.

Nothing in this section of MCMILLAN, or anywhere else in MCMILLAN says anything about a "publish request" from a sender computer as recited in claims 4-6. MCMILLAN does not discuss how the server acquires the email addresses to which emails are sent. Col. 4, lines 15-31 teach that the sender (i.e., the "customer" initiates the document distribution process by providing the server with a "job sheet" indicating the content to be sent and other parameters, but MCMILLAN does not indicate that recipient email addresses are included on the job sheet.

Claims 7 and 8

Claims 7 and 8 depend on claim 1 and are patentable over MCMILLAN for similar reasons.

The Examiner indicates at paragraph 8, that "Claim 7 is rejected for similar reasons as stated above." The applicant assumes that the Examiner is referring to the remarks of paragraph 5 of the office action regarding claim 4, since claim 4 has some limitations in common with claim 7. Hence, the applicant's remarks above concerning claim 4

serve to distinguish claims 7 and 8 over MCMILLAN with respect to those limitations.

Claims 7 and 8 also recites a step of transmitting a publish request from the sender computer to the server computer indicating that the sever must sign on the server with user name and password in order to receive the document file. MCMILLAN describes a "job sheet" at col. 4, lines 16-31 through which a sender specifies various parameters about the document distribution job to be carried out, but the job sheet does not include any indication that a receiver must sign on the server computer. While MCMILLAN (col. 6., lines 2-9) teaches a login is required when a sender wants to view data a server logs concerning a file, nothing in MCMILLAN teaches that a publish request from a sender should mandate that a receiver should log into a server in order to obtain a media file.

The Examiner points to MCMILLAN, FIG. 13, col. 9, lines 15-53 and col. 8, lines 17-48 as disclosing steps of verifying a receiver is logged on to the sever computer and thereafter transmitting a document file to the receiver computer. However while FIG. 12 and col. 9 and lines 15-53 do mention logins and passwords, the log-in process the section of MCMILLAN refers to is a log-in required when an authorized "partner" (a sender's representative) logs in to a server for the purpose of reading the data that the server has logged regarding access to data files. See col. 6, lines 5-9. MCMILLAN does not teach that the intended receiver of the data files should be required to log into to the server to get them.

Claim 13

Claim 13 depends on claim 1 and is patentable over MCMILLAN for similar reasons. Claim 13 further recites that the receiver computer returns the verification data to the server computer in the form of an encoded network address. The Examiner points to MCMILLAN col. 9, lines 15-52 as teaching this, but this section of MCMILLAN says nothing about software in a receiver sending a network address to the server indicating that the receiver computer has successfully viewed a document. Col. 9, lines 15-29 talk only about the kinds of data the server logs, none of which are network addresses encoded to indicate a receiver computer has successfully viewed a documents. Lines 30-52 teach that the server that sends out documents requested by the

software embedded in the email should report any problems to a "session manager" which stores various information about the data transmission process in a transaction log. However, nothing in that section of MCMILLAN teaches anything about software in a receiver sending a network address to the server indicating that the receiver computer has successfully viewed a document.

Claims 14-17 and 21.

The Examiner rejects claims 14-17 for reasons similar to those stated in connection with claims 1, 2, 4-8, and 13. The applicant's comments above regarding claims 1, 2, 4-8 and 13 therefore serve to distinguish claims 1, 2, 4-8 and 13 over MCMILLAN.

Claim 14 recites verification data similar to claim 1 and that the data is included in an encoded network address as recited in claim 13. As discussed above, MCMILLAN does not teach these aspects of the invention.

Claim 15 recites that the publication request includes the receiver to receive the email address and is therefore distinguishable over MCMILLAN for reasons similar to those discussed above in connection with claim 4.

Claims 16 and 17 are distinguishable over MCMILLAN for reasons discussed above in connection with claim 7 and 8.

Claim 21 is distinguishable over MCMILLAN because it recites storing log data on the server indicating when the receiver computer returned the verification data. As discussed above, MCMILLAN does not teach that the receiver computer should return verification data, and there is no discussion in MCMILLAN of logging such verification data.

3. Claims 9, 10 and 20 are rejected under 25 U.S.C. 103(a) as being unpatentable over MCMILLAN in view of U.S. patent 6,209,030 (OHASHI). The Examiner is respectfully requested to withdraw the rejection of these claims in view of the following comments distinguishing claims 9, 10 and 20 over the combination of MCMILLAN and OHASHI.

Claims 9 and 10

Claims 9 and 10 depend on claim 1 and the examiner relies on MCMILLAN as teaching the limitations of claim 1 and cites OHASHI as

teaching the additional limitations recited in claim 9. The applicant's comments above relative to claim 1 show that MCMILLAN fails to teach or suggest the subject matter of parent claim 1.

Claim 9 further recites that the sender computer sends a publication request identifying a receiver computer. As discussed above in connection with claims 4-6, nothing in MCMILLAN discloses or teaches that a sender computer sends a publication request identifying a receiver computer to a server computer. OHASHI teaches only interactions between a server computer 10 and receiver computers 11 as illustrated in FIG. 3, and does not teach any interactions between a sender computer and a server computer. OHASHI does not contemplate a sender computer.

Claim 9 further recites that a publication request indicates that a receiver computer is to be prevented from sending the document file to a printer. Nothing in either MCMILLAN or OHASHI mentions or suggests anything about a server sending a publication request indicating that a particular receiver computer is to be prevented from printing a document file.

The Examiner cites OHASHI (Abstract) as disclosing a mechanism by which a receiver computer may be preventing from performing a print screen operation when displaying a document in a browser. However claims 9 and 10 (as amended) recite that the receiver computer is prevented from sending the document file (which is a print file) to a printer. Sending a print file describing a document to a printer, and carrying out a print screen operation are not the same activities. In a print screen operation, a copy of whatever is displayed on a screen is printed. Though a receiver computer may display a document or a portion of a document described by a document file (such as an html file) on a screen, a print screen command does not send the document file itself to the printer. A print screen command creates a new print file describing only what appears on the screen on a pixel-by-pixel basis and then sends that new print file to the printer. The invention, as recited in claims 9 and 10 relates to displaying a document described by a print file on a receiver computer, and preventing the receiver computer from sending the print file to a printer. Neither MCMILLAN nor OHASHI teach or suggest this.

Claim 20

Claim 20 depends on claim 14 and 15 and the Examiner relies on MCMILLAN as teaching the subject matter of claims 14 and 15. The applicant's comments above explain why MCMILLAN fails to teach the subject matter of claims 14 and 15. Claim 20 further recite that the publish request indicates that the receiving computer is to be prevented from sending the document file to a printer. As discussed above relative to claims 9 and 10, MCMILLAN and OHASHI fail to disclose publication requests containing this kind of information, and while OHASHI teaches preventing a receiving computer from carrying out a print screen operation, OHASHI does not teach preventing a receiving computer from sending a document file to a printer.

4. Claims 11, 12, 18 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over MCMILLAN in view of U.S. patent 6,237,099 (KUROKAWA). The Examiner is respectfully requested to withdraw the rejection of these claims in view of the following comments distinguishing them over the combination of MCMILLAN and KUROKAWA.

Claims 11 and 12

Claims 11 and 12 depend on claim 1. The examiner cites MCMILLAN, but not KUROKAWA, as disclosing the content of parent claim 1 and cites KUROKAWA as teaching the additional limitations of claims 11 and 12. However as discussed above in connection with claim 1, MCMILLAN does not teach the subject matter of claim 1. Since KUROKAWA also fails to disclose the subject matter of claim 1, claims 11 and 12 are patentable over the combination of MCMILLAN and KUROKAWA.

Claims 18 and 19

Claims 18 and 19 depend on claims 14 and 15. The examiner cites MCMILLAN, but not KUROKAWA, as disclosing the content of parent claims 14 and 15 and cites KUROKAWA as teaching the additional limitations of claims 18 and 19. However as discussed above in connection with claims 14 and 15, MCMILLAN does not teach the subject matter of claims 14 and 15. Since KUROKAWA also fails to disclose the subject matter of claims 14 and 15, claims 18 and 19 are patentable over the combination of MCMILLAN and KUROKAWA.

5. Claims 3 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over MCMILLAN in view of U.S. patent 6,243,722 (DAY). The Examiner is respectfully requested to withdraw the rejection of these claims in view of the following comments distinguishing them over the combination of MCMILLAN and DAY.

Claim 3

Claim 3 depends on claim 1. The Examiner cites MCMILLAN, but not DAY, as disclosing the content of parent claim 1 and cites DAY as teaching the additional limitations of claim 3. However as discussed above in connection with claim 1, MCMILLAN does not teach the subject matter of claim 1. Since DAY also fails to disclose the subject matter of claim 1, 3 is patentable over the combination of MCMILLAN and DAY.

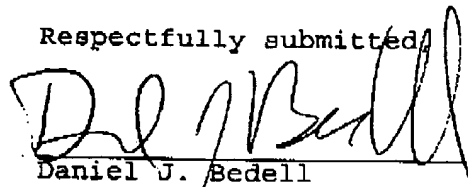
Claim 22

Claim 22 depends on claim 14. The Examiner cites MCMILLAN, but not DAY, as disclosing the content of parent claim 14 and cites DAY as teaching the additional limitations of claim 22. However as discussed above in connection with claim 1, MCMILLAN does not teach the subject matter of claim 14. Since DAY also fails to disclose the subject matter of claim 1, 3 is patentable over the combination of MCMILLAN and DAY.

6. The prior art cited but not relied upon has been reviewed and does not appear to disclose or suggest the applicant's invention as claims.

7. In view of the foregoing amendments and remarks it is believed the application is in condition for allowance. Notice of Allowance is therefore respectfully requested.

Respectfully submitted,


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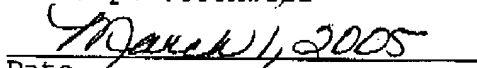
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